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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/216,545	12/18/1998	THOMAS HAROLD ROESSLER	14.541	9533

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KIMBERLY-CLARK WORLDWIDE, INC.  
401 NORTH LAKE STREET  
NEENAH, WI 54956

EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 11/25/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/216,545

Applicant(s)

ROESSLER ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 40-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 40-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Specification***

1. The amendment to page 22, lines 1-7 does not comply with 37 CFR 1.121 because such does not include the entire paragraph and the portion provided does not correspond textually to page 22, lines 1-7 as they appear in the application. Any response to this action should include an amendment which is in compliance with 37 CFR 1.121.

### ***Drawings***

2. The corrected or substitute drawings were received on 7-8-03(Figures 1-2 and 4) and 6-27-01(Figure 3). These drawings are approved by the Examiner.

### ***Description***

3. The abstract of the disclosure is objected to because the abstract is still too long, i.e. must be no more than 150 words in length for printing purposes. Correction is required. See MPEP § 608.01(b).

4. The disclosure is objected to because of the following informalities: In the Summary of the Invention section, page 22 of the amendment, line 2, "are" should be --is--, on line 5, "panels" should be --panel-- and "edges" should be --edge--.

Appropriate correction is required.

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***Claim Objections***

5. Claim 49 is objected to because of the following informalities: In claim 49, subsection f), line 2, "one" should be --on--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 40-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over SCA '290 in view of McNichols '805.

With regard to claims 40-49: See SCA '290 at Figures; page 9, lines 17-20; page 5, lines 9-11, the absorbent chassis; elements 28 and 4, page 7, lines 18-24, page 11, lines 11-15, the elastic back panel 13; page 5, line 19-page 6, line 10, page 7, lines 6-7, page 11, lines 11-15, elastic front panel 8 and separate 5 or unitary engaging portions; page 10, lines 10-11, the seam 17. The SCA device, see preceding rejection, includes all the claimed structure except for the releasable bond as set forth in subsection e) of claim 40 and the specifics thereof in the dependent claims 46-48. However, McNichols teaches a similar device which also includes a releasable bond to improve reliability of maintaining the article in a prefastened condition

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particularly when it is being pulled on or off the hips, i.e. to maintain the shape of and put on like a pair of ordinary underpants, see col. 15, line 9- col. 16, line 19 of McNichols. To employ a releasable bond as taught by McNichols on the SCA device would be obvious to one of ordinary skill in the art in view of the recognition that such would improve the reliability of maintaining the prefastened condition during use and the desirability of such by SCA, attention is reinvited to page 9, lines 17-20 of SCA. With regard to claim 49, it is a product by process claim. In accord with MPEP 2113, even though the product of the prior art combination is made by a different process, since the end product is obviously the same as the end product of claim 49, the claim does not distinguish over the prior art.

8. Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as McNichols '805 at the time this invention was made. Accordingly, McNichols '805 is disqualified as prior art through 35 U.S.C. 102(f) or (g) in any rejection under 35 U.S.C. 103(a) in this application. However, this applied art additionally qualifies as prior art under another subsection of 35 U.S.C. 102 and accordingly is not disqualified as prior art under 35 U.S.C. 103(a).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

### ***Response to Arguments***

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9. Applicant's remarks on pages 9-11 with regard to formal matters have been considered but are either deemed moot in that the issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra. Applicant's remarks with regard to the prior art on pages 11-14 have been carefully considered but are either deemed moot, i.e. the double patenting rejection on 6,113,717 was overcome by the filing of a terminal disclaimer and the common ownership of 706,294 and 6,113,717 was established, in that the issue has not been reraised or is deemed nonpersuasive for the reasons set forth supra. Specifically 35 USC 103<sup>9</sup> as amended by AIPA disqualifies references used in a 103(a) rejection that only qualify as prior art under 102(e), (f) and (g) against the claimed invention in applications filed on or after 11-29-99 (does not apply to RCE if the underlying application was filed prior to 11-29-99) if Applicant submits the required evidence in the form of a statement of common ownership. The McNichols reference qualifies as prior art under 35 USC 102(a) however and the instant application is an RCE of a underlying application which was filed prior to 11-29-99. Therefore, a statement of common ownership is insufficient to overcome disqualify the McNichols reference. See paragraph 8 supra.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any new grounds of rejection were necessitated by the amendments to claim 49.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to K. M. Reichle whose telephone number is 703-308-2617. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo, can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

KMR

November 18, 2003

*K.M. Reichle*  
**KARIN REICHLÉ**  
**PATENT EXAMINER**